09/447,912

REMARKS

Reconsideration of the above referenced application in view of the following amendments and remarks is requested. Claims 27-48 remain in the application. The Office action summary of September 3, 2003 does not state that claims 27-30 have been examined, yet examination of these claims has apparently occurred according to the remainder of the Office action. Clarification of the summary is desired by the Applicants.

ARGUMENT

Claims 27-31, 33, 36-40, 42, 45, 47, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laor (US Pat. 6,076,069), in view of Gabber et al. (US Pat. 5,961,593)(hereinafter Gabber), and further in view of Kunzelman, et al. (US Pat. 6,041,357)(hereinafter Kunzelman.

Claim 27 is allowable over the cited combination of Laor, Gabber, and Kunzelman. The Examiner has neglected to examine claim 27 as a whole. Instead, *the Examiner has used a piecemeal approach to finding disparate elements of claim 27 in the prior art, and then has used <u>impermissible hindsight</u> to reconstruct the claimed invention using the improbable combination of portions of Laor, Gabber and Kunzelman.* Such hindsight is not allowed based on the holdings of the Court of Appeals for the Federal Circuit (CAFC), and the rejection of claim 27 must be withdrawn.

To reiterate earlier arguments, the present invention operates in a <u>fundamentally different</u> manner than the cited prior art. The club member communicates with the club manager web site to register as a club member and to request a benefit (after viewing or otherwise receiving information about club benefits from the club manager). The club manager web site communicates directly with the affiliate web site by sending a credential to the affiliate, the credential

7

09/447,912

including the value token associated with the club member. The affiliate web site authenticates the credential, and provides the benefit <u>directly</u> to the club member if the credential is valid.

Note that no cookies or other intrusive measures are used. Note also that the club member receives the benefit <u>directly from the affiliate web site without having to communicate further with the club manager. No proxy servers or proxy web sites are used.</u> Additionally, *the Applicants wish to point out that the limitations of claim 27 specifically require a particular arrangement of entities and communications paths.* There are three entities: 1) the club manager web site, 2) the affiliate web site, and 3) the club member (i.e., user's PC and browser). The club member communicates with the club manager web site to register as a club member and to request a benefit. The club manager web site communicates with the affiliate web site to send the credential including the value token to the affiliate web site. The club member communicates with the affiliate web site to receive the benefit associated with the credential without further communication with the club manager. These recited limitations of separate elements and particular communications paths must be considered in assessing the patentability of the claim as a whole.

Claim 27 is not taught or suggested by the combination of Laor and Gabber. The addition of Kunzelman to disclose a cryptographically signed token does not negate the illogical combination of Laor and Gabber cited by the Examiner. (The Applicants fail to see how the additional citation of Kunzelman cures the deficiencies in the Examiner's argument with respect to the combination of Laor and Gabber.) Neither Laor or Gabber, alone or in combination, teach or suggest the specific arrangement and interaction of the club manager web site, affiliate web site, and club member as described above and in the Specification, and as claimed in claim 27, taking into account all limitations and *looking at the claim as a whole.* Substituting the cookie system of Laor with the proxy system of Gabber (as asserted by the Examiner) would not result in the claimed invention because the claimed invention does not use a proxy as a club manager to be "in the middle" of all communication (i.e., a conduit) between a user/club member and an affiliate web site. The arrangement of entities as claimed in the present invention is

8

09/447,912

fundamentally different than the teachings and suggestions of the cited art. The combination of the cited art would <u>not</u> result in the claimed invention. In one sense, the disparate architectures of Laor and Gabber are alternative designs, and <u>one</u> <u>skilled in the art at the time the invention was made would not think that combining</u> <u>these two disparate architectures would result in the claimed invention because the</u> <u>claimed invention is yet another alternative system architecture, not a composite of</u> <u>the teachings of Laor and Gabber</u>. One of ordinary skill in the art at the time the invention was made would not make the present invention based on the teachings and suggestions of Laor and Gabber, as well as Kunzelman, because *such a combination simply would not work*. The Examiner's assertion of *replacing Laor's cookie technique with Gabber's proxy server makes no sense in the configuration of the present invention*.

Accordingly, there is <u>no</u> incentive or suggestion to combine the disparate teachings of these references to arrive at the present invention. The CAFC has clearly held that there must be a suggestion to combine the teachings of multiple references when making an obviousness rejection. This requirement has not been fulfilled here, because the combination wouldn't work as the claimed invention does.

The Examiner makes note of the diagrams provided by the Applicants to explain the differences between the system architectures of Laor, Gabber, and the present invention, and contends that Laor teaches that the benefit is delivered to the club member without having further communication with the club manager, as claimed. However, Laor has a fundamentally different system architecture than the present invention. The fact that one claim limitation may be found in Laor does not provide sufficient basis for the rejection of claim 27 as a whole, because the combination of Laor and Gabber does not result in the claim 27. In knowing the architecture of Laor, and knowing the architecture of Gabber, one skilled in the art at the time the invention was made would not create the invention recited in claim 27.

For all of the above reasons, a prima facie case of obviousness has not been made based on the cited art. Claim 27 is allowable as presented. Nonetheless, in the interests of compact prosecution, a limitation has been added to claim 27. Claim 27 now requires that the club member registers for the club prior to the

9

09/447,912

affiliate. That is, this covers the situation of an affiliate being added to provide benefits to club members after the member has already joined the club. This is clearly not taught or suggested by the combination of Laor, Gabber, and Kunzelman. Prompt allowance of claim 27 is requested.

As to claim 28, it depends from allowable claim 27. Gabber's system does appear to allow for an anonymous club member. However, the way it does this is by using a proxy server as the club manager. The present invention does not use a proxy server, as discussed above. Hence, Gabber does not suggest claim 28. Since claim 28 depends from allowable claim 27, it is also allowable.

As to claims 29 and 30, they depend from allowable claim 27. Therefore, they are also allowable.

As to claim 31 and 40, these claims require that no further interaction between the club member and the club manager web site take place during the operation of providing the benefit to the club member by the affiliate web site. In contrast, Gabber teaches a proxy system where the club manager is a proxy server that serves as a conduit for all communications between the club member and the affiliate web site. As such, Gabber teaches away from this limitation of claims 31 and 40. Furthermore, the combination of Laor and Gabber would not produce a system that performs the recited steps by the appropriate entities in the recited order. Since Gabber teaches a proxy server and the present invention has no proxy server, the communication steps recited in claims 31 and 40 cannot be performed as claimed by a system composed of the teachings of Gabber and Laor. In addition, the argument presented above with respect to claim 27 is equally applicable to claims 31 and 40. The combination of Laor and Gabber does not teach or suggest the specific steps claimed. Instead, the Examiner has attempted to find disparate teachings and suggestions in the cited art in a piecemeal approach to find the present claim limitations. This has been done without taking the claim as a whole. Although some of the limitations may be found in the cited art, the combination of the cited art does not result in a working system meeting the claim as a whole.

The Examiner makes note of the diagrams provided by the Applicants to explain the differences between the system architectures of Laor, Gabber, and the

09/447,912

present invention, and contends that Laor teaches that the benefit is delivered to the club member without having further communication with the club manager, as claimed. However, Laor has a fundamentally different system architecture than the present invention. The fact that one claim limitation may be found in Laor does not provide sufficient basis for the rejection of claim 31 as a whole, because the combination of Laor and Gabber does not result in the claim 31. In knowing the architecture and processing steps of Laor, and knowing the architecture and processing steps of Gabber, one skilled in the art at the time the invention was made would not create the invention recited in claim 31.

Since the combination of Laor and Gabber do not teach or suggest claims 31 and 40 (taken as a whole), these claims are allowable. Therefore, claims 31 and 40 are allowable as presented. Furthermore, claims 31 and 40 have been amended to more particularly recite the present invention. These claims now require that the affiliate web site joins the club after the club member. The combination of the cited references does not teach or suggest claims 31 and 40, as currently presented and taken as a whole.

As to claims 33 and 42, since they depend from allowable independent claims 31 and 40, respectively, they are also allowable.

As to claims 36 and 45, since they depend from allowable independent claims 31 and 40, respectively, they are also allowable.

As to claims 37 and 46, they depend from allowable claim 31 and claim 40, respectively. Hence, claims 37 and 46 are also allowable.

In regard to claims 38 and 47, *the claimed limitations are neither in the cited text of Gabber, nor found elsewhere in Gabber.* Gabber teaches using an electronic form on a web page to obtain information from the user. This operation is performed by a single web site (e.g., the NY Times web site as shown in Gabber at col. 11, line 7). The form on the web page in Gabber does not teach or suggest anything about communicating signed value tokens between web sites. Instead, Gabber simply teaches using a form to obtain data from a user from a *single* web page. Gabber does <u>not</u> teach or suggest using <u>a form post from a club manager web site to an affiliate web site to pass a signed value token.</u>

11

09/447,912

    This argument was previously presented to the Examiner, yet has not been responded to. The Applicants respectfully request the Examiner to consider the deficiencies in the application of Gabber on this point and to show exactly where in Gabber the claim limitations are taught or suggested. Without more, the claims are allowable as presented.

    In addition, claims 38 and 47 depend from allowable claims 31 and 40. Claims 38 and 47 are allowable as presented.

    As to claims 39 and 48, the cited text of Gabber merely describes displaying an HTML document in a browser (as is currently notoriously well known). Neither Gabber nor Laor, alone or in combination, teach the claimed limitation of <u>passing a signed value token between a club manager web site to an affiliate web site in a DHTML link using the web browser of the club member</u>. Merely mentioning web browsers and HTML is insufficient to teach or suggest the claimed limitation. The claim must be examined as a whole; the limitation is not found in the references because the references do not teach or suggest passing a signed value token between a club manager web site to an affiliate web site in a DHTML link using the web browser of the club member.

    This argument was previously presented to the Examiner, yet has not been responded to. The Applicants respectfully request the Examiner to consider the deficiencies in the application of Gabber on this point and to show exactly where in Gabber the claim limitations are taught or suggested. Without more, the claims are allowable as presented.

    In addition, claims 39 and 47 depend from allowable claims 31 and 40. Claims 39 and 48 are allowable as presented.

    Claims 32, 35, 41, and 44 are rejected under 35 USC 103(a) as being unpatentable over the combination of Laor, Gabber, and Kunzelman, further in view of Barnett, et al. (US 6,321,208)(hereinafter Barnett).

    As to claims 32 and 41, since they depend from allowable independent claims 31 and 40, respectively, they are also allowable.

12

09/447,912

As to claims 35 and 44, since they depend from allowable independent claims 31 and 40, respectively, they are also allowable.
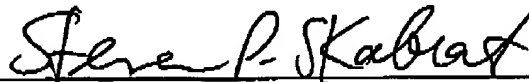
Claims 34 and 43 are rejected under 35 USC 103(a) as being unpatentable over the combination of Laor, Gabber, and Kunzelman, further in view of Eggleston, et al. (US 6,061,660)(hereinafter Eggleston).

As to claims 34 and 43, since they depend from allowable independent claims 31 and 40, respectively, they are also allowable.

CONCLUSION

In view of the foregoing, Claims 27-48 are all in condition for allowance. If the Examiner has any questions, the Examiner is invited to contact the undersigned at (503) 264-8074. Early issuance of Notice of Allowance is respectfully requested.

Respectfully submitted,

Dated: 3/10/04

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